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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,704	04/14/2006	Thomas J Gardella	00786/539001	5389
21559	7590	05/13/2008		
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110			EXAMINER LUKTON, DAVID	
			ART UNIT 1654	PAPER NUMBER
			NOTIFICATION DATE 05/13/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentadministrator@clarkelbing.com

Office Action Summary

Application No.

10/542,704

Applicant(s)

GARDELLA ET AL.

Examiner

DAVID LUKTON

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1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 2-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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Applicants' election of Group I (claim 1) is again acknowledged. The elected species are as follows:

i) the condition to be treated is type I osteoporosis;

ii) the route of administration is intravenous;

iii) the elected peptide is the following:

SVSEIELMHKLGKHLNSMERVEWLRKKLQDVMNX

(wherein "X" represents tyrosine carboxamide)

Claim 1 is examined in this Office action; claims 2-16 are withdrawn from consideration.

▲

Claim 1 is objected to. In the phrase "SEQ. ID. NO. 31", the periods should be eliminated, and a semicolon used between "NO" and "31", i.e., the following:

SEQ ID NO:31

▲

The following is a quotation of 35 USC, §103 which forms the basis for all obviousness rejections set forth in the Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made, absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

Claim 1 is rejected under 35 U.S.C. §103 as being unpatentable over Gardella (USP 7022815).

Gardella discloses SEQ ID NO: 16, the first 15 amino acids of which are the following:

AVAEIQLMHDLRKWL

Instant claim 1, part (b) is drawn to any “analog” that contains each of the first 15 amino acids of SEQ ID NO:31 (sequence of the instant application). At the very least, instant claim 1 encompasses the following peptide:

AVAEIELMHDLRKWL

Thus, according to one embodiment, claim 1 could be interpreted to encompass any peptide (that is effective to treat osteoporosis) which contains at least one Ala, at least one Val, at least one Ile, at least one Glu, at least one Leu, at least one Met, at least one His, at least one Asp, at least one Arg, at least one Lys, and at least one Trp. In other

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words, claim 1 part (b) doesn't actually require that the 15 amino acids of the "analog" be **contiguous**, relative to what is present in SEQ ID NO:31.

It is true that the peptide of Gardella requires a glutamine at position 6, which is not specifically suggested by instant claim 1. But the point is that claim 1 does not exclude this peptide either; instant claim 1 encompasses any "analog" that contains (whether contiguous or not) each of the amino acids that are present in the N-terminus 15-mer of SEQ ID NO: 31.

One option here might be to delete the current part (b) of claim 1, and to replace it with the following:

- - (b) a fragment of SEQ ID NO:31 containing the subsequence:

X₀₁-Val-X₀₂-Glu-Ile-X₀₃-Leu-Met-His-X₀₄-X₀₅-X₀₆-Lys-X₀₇-Leu - -

▲

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

/David Lukton/

Primary Examiner, Art Unit 1654